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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/630,938 08/02/00 LUSSIER

M ADI-022

021323 QM12/1011  
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EXAMINER

PATTERSON, M

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

10/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/630,938

Applicant(s)

Lussier

Examiner

Marie Patterson

Art Unit

3728



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Aug 31, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1, 4-23, 26-31, and 35-38 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1, 4-23, 26-31, and 35-38 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☒ The proposed drawing correction filed on Aug 31, 2001 is: a) ☐ approved b) ☒ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

Art Unit:

***Drawings***

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 8/31/01 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of the specific shading shown in all of the amended drawings or for the added shaping of figures 1B, 1C, 1D, 1E, 1G, 2B-G, and 3B-G.
2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the different thicknesses (as claimed in claims 12-16), different materials (as claimed in claims 17 and 18), and an intermediate layer (as claimed in claims 32-34) must be shown or the feature(s) canceled from the claim(s). **No new matter should be entered.** It is noted that the proposed drawing corrections do show such, but by showing such they contain new matter in the exact dimensions and locations of such elements.

***Specification***

3. The amendment filed 8/31/01 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the reference to the shading in the new drawings..

Applicant is required to cancel the new matter in the reply to this Office action.

Art Unit:

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification, as originally filed, does not provide support for the invention as now claimed.

There is no basis in the original specification for the limitation of “the chassis is substantially flat in the toe portion” as claimed in amended claims 1, 20, and 26. The chassis shown in the drawings clearly show a toe portion which is curved.

Art Unit:

***Claim Rejections - 35 USC § 112***

5. Claims 1, 4-23, 26-31, and 35-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

6. Claims 1, 4-23, 26-31, and 35-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 20, and 26 the phrase “the chassis is substantially flat in the toe portion” is confusing, vague, and indefinite because it is not clear what structural limitations applicant intends to encompass with such language in view of the specification which shows a forefoot portion which is curved.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 6, 8, 9, 19-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Giese (5572805, see figures 127-131).

Art Unit:

9. Claims 1, 5, 6, 8, 9, 12-16, and 19-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Giese (5572805, see figures 100-103).

In reference to claims 22 and 23, a “lug” is shown in figures 102 and 103.

10. Claims 26, 29, 30, 31, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Hockerson (WO 98/20763).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 4, 6-9, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (444735) in view of Trimpop (German 29700699).

Thomas shows a chassis comprising forefoot and rearfoot elongated elements (figure 1) substantially as claimed except for the exact materials and specifically showing of the forefoot portions being “substantially flat”. Trimpop teaches the use of a polymeric material for a chassis and teaches making the chassis “substantially flat” (figures 1 and 2). It would have been obvious to use a polymeric material and to make the chassis substantially flat as taught by Trimpop in the chassis of Thomas to increase durability and to make the chassis easy to manufacture.

Art Unit:

13. Claims 1, 4, 6-10, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiss (1484785) in view of Trimpop.

Hiss shows a chassis comprising forefoot elongated element (5 which is substantially flat inasmuch as applicant has disclosed such) and rearfoot elongated elements (sides of opening 6), and an opening (6) substantially as claimed except for the exact materials for the chassis.

Trimpop teaches the use of a polymeric material (plastic) for a chassis. It would have been obvious to use a polymeric material as taught by Trimpop for the chassis of Hiss to increase durability and to make the chassis easy to manufacture.

In reference to the intended length of the forefoot elements, it is noted that such a limitation is dependent on the shoe in which the chassis is placed and the chassis of Hiss is clearly capable of being placed in a shoe which would result in the elements 5 extending substantially the entire length of the shoe, also the elements 5 of Hiss could be construed to be "substantially" the entire length of the shoe. Furthermore, Trimpop clearly teaches extending forefoot elongated elements through the entire forefoot area and also teaches the use of 3 elongated elements.

In reference to claim 10, the shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of a chevron to make the opening easier to manufacture/cut.

14. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 1, 4, 6-10, and 19-21 above, and further in view of Kendall (5713143).

Art Unit:

Hiss as modified above shows a chassis substantially as claimed except for the opening being open to the side. Kendall teaches opening a heel area to the side in a chassis. It would have been obvious to provide a side opening as taught by Kendall in the chassis of Hiss to increase flexibility and comfort in the heel.

15. Claims 10, 13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese.

Giese shows a shoe sole with chassis substantially as claimed except for the exact shape of the opening in the heel. The shape of the opening is considered to be a choice of design and it would have been obvious to make the opening in the shape of a chevron to make the opening easier to manufacture/cut.

In reference to claims 17 and 18, Giese teaches the well known use of different materials to provide different properties in different areas (column 13 lines 15-40). It would have been obvious to use different materials in different regions of the chassis of Giese to provide increased flexibility in areas which require such.

16. Claims 26-30 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giese in view of Crowley (4393604)

Giese shows a shoe substantially as claimed except for cleats on the sole. Giese suggests different contours for the outsole to increase traction of the sole (column 14 lines 20-23).

Crowley teaches forming an outsole with molded cleats thereon as is well known. It would have been obvious to provide cleats as taught by Crowley on the outsole of Giese to increase traction.



Art Unit:

In reference to claims 35-38, Giese shows a shoe sole with a skin layer (the bottom layer in figures 112-115), an intermediate film (shown in figures 112-115, which inherently has color), and a chassis (19). The use of transparent materials for outer sole elements is extremely well known to allow an interior element to be seen. It would have been obvious to make the outer skin layer transparent as is well known in the shoe of Giese to allow the interior elements to be seen.

17. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 26-30 and 35-38 above, and further in view of Cameron (3739497) or Barre (5473827).

Giese as modified above shows a shoe substantially as claimed except for providing a lug on the chassis which extends into the cleat. Cameron or Barre teaches providing lugs (32 or 23) on a chassis which extends into a cleat (24 or 11). It would have been obvious to provide lugs which extend into the cleat as taught by either Cameron or Barre in the shoe of Giese as modified above to increase stability and durability of the layered sole.

### ***Response to Arguments***

18. Applicant's arguments filed 8/31/01 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the specific length of the chassis in reference to a shoe, it is noted that claims 1 and 4-23 are directed solely to the chassis and therefore such a limitation is dependent on an undefined element. The prior art chassis are clearly capable of being placed in shoes which would result in the chassis extending substantially the

Art Unit:

entire length of the shoe. Also, the lengths of the chassis of the prior art is considered to be “substantially” the entire length of the shoes.

In response to applicants’ arguments directed towards Giese, the chassis shown in figures 100-103 and 127-131 are clearly shown as extending substantially the entire length of a shoe.

Applicants arguments directed towards the layers not be integrally formed, these arguments are not understood. Furthermore it is noted that a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are

Art Unit:

evaluated by what they suggest to one versed in the art, rather than by their specific disclosures.

*In re Bozek*, 163 USPQ 545 (CCPA) 1969.

19.

Applicant's arguments with respect to claims 1, 4-23, 26-31, and 35-38 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

21. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily

Art Unit:

provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648.

For applicant's convenience, the Group Technological Center FAX number is \*703) 305-3580. Please identify Examiner \_\_\_\_ of Art Unit \_\_\_\_ at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to Valerie Douglas at (703) 308-1337.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson  
Primary Examiner  
Art Unit 3728

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a)

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.